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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,186	03/19/2001	Chieko Ohsumi	204934US0	6978

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/810,186

Applicant(s)

OHSUMI ET AL.

Examiner

Cynthia Collins

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 17 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 28-47.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Cynthia Collins* 3/29/05

Continuation of 3. NOTE: (a) addition of the limitations "growing plants under drought conditions to select" and "growing plants under high salt conditions to select" raises new issues that would require further consideration under 35 USC 112, 1st paragraph with respect to growing plants under drought or high salt conditions as a means of selecting plants which have higher drought or salt resistance; (b) addition of the limitations "growing plants under drought conditions to select" and "growing plants under high salt conditions" raises the issue of new matter in that growing plants under drought conditions or high salt conditions as a means of selecting plants which have higher drought or salt resistance does not find support in the specification as originally filed and thus constitutes new matter.

Continuation of 5. Applicant's reply would overcome the following rejection(s): addition of the proposed limitations "growing plants under drought conditions to select" and "growing plants under high salt conditions to select" would, if entered, overcome the rejection of claims 28-47 under 35 U.S.C. 102(a) as being anticipated by EP 0 994 186 A1 (AJINOMOTO CO. INC., 19.04.2000), the rejection of claims 28-31 and 38-41 under 35 U.S.C. 102(b) as being anticipated by EP 0 849 359 A2 (SUMITOMO CHEMICAL CO, 24.06.1998), and the rejection of Claims 28-47 under 35 U.S.C. 102(b) as being anticipated by JP411123080-A (AJINOMOTO CO. INC., May 11, 1999).

Continuation of 11. does NOT place the application in condition for allowance because: while EP 0 994 186 A1 (AJINOMOTO CO. INC., 19.04.2000), EP 0 849 359 A2 (SUMITOMO CHEMICAL CO, 24.06.1998), and JP411123080-A (AJINOMOTO CO. INC., May 11, 1999) do not teach "growing plants under drought conditions to select plants which have higher drought resistance compared to plants prior to introducing the polynucleotide", or "growing plants under high salt conditions to select plants which have higher resistance to high salt concentration compared to plants prior to introducing the polynucleotide", these limitations do not find support in the specification as originally filed and thus constitute new matter. Applicant's assertions at page 6 of the reply that the amendments are supported by the specification are unconvincing. With respect to the first full paragraph at page 15 of the specification, this paragraph refers to "The resulting transgenic plant" (which excessively expresses raffinose synthetase and can be obtained by introducing raffinose synthase gene as described above into the plant body, last paragraph at page 13 of the specification) that "possesses improved stress resistance", referred to in the last paragraph at page 14 of the specification. "Improved resistance against stress including high salt concentration and/or drought conditions means that the degree of growth suppression" of the resulting transgenic plant "is subdued even under conditions which suppress the growth or allow no growth of wild type plants". The first full paragraph at page 15 of the specification makes no reference to growing plants under drought or high salt conditions as a means of selecting plants which have higher drought or salt resistance. With respect to section 4 at pages 24-25 of the specification, this section describes growing transformed plants under drought conditions as a means of demonstrating that the transformants exhibit drought resistance superior to wild type plants. Section 4 at pages 24-25 makes no reference to growing plants under drought conditions as a means of selecting plants which have higher drought resistance.